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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,311	03/12/2004	Wilfried Blum	P1112US00	5775
76753 7590 08/13/2009 BENOIT & COTE, s.e.n.c. 1001, DE MAISONNEUVE BOULEVARD WEST SUITE 210 MONTREAL, QC H3A 3C8 CANADA			EXAMINER FISHER, PAUL R	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 08/13/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/798,311	Applicant(s) BLUM ET AL.	
	Examiner PAUL R. FISHER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7, 9-20, 28-29, 31-34, and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment submitted on June 4, 2009 has been acknowledged. Claims 3, 8, 21-27, 30 and 35 have been canceled. Claim 42 is new. Claims 1-2, 4-7, 9-20, 28-29, 31-34, and 36-42 are currently pending and have been considered below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly recited limitation of "said assessment comprising a grade for the vehicular part" found in claims 1, 28 and 41 has no support in the applicant's specification. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. Since they are equivalent there is no support for the assessment to comprise a grade, and that the grade and not the assessment is used to determine the disposition of the part.

4. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains

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subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. Since they are equivalent there is no support for the assessment to comprise a grade, and that the grade and not the assessment is used to determine the disposition of the part. One of ordinary skill in the art would not be able to perform the claimed invention based on the specification since there is no clear guidance as to how the assessment can comprise a grade when the grade is equivalent to the assessment.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In claim 1, the recited term "said assessment comprising a grade for the vehicular part", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

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8. Claims 2, 4-7, 9-20, and 38-40 depend from claim 1 and are therefore rejected upon the same rationale.

9. In claim 28, the recited term "include said grade of said assessment", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

10. Claims 29, 31-34, 36-37 and 42 depend from claim 28 and are therefore rejected upon the same rationale.

11. In claim 41, the recited term "the assessment comprising a grade for the vehicular part", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-2, 4-7, 9-20, and 38-41 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or

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apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because while the claims recite a central server outputting information or sending information the steps of sending or outputting are considered insignificant steps or insignificant extra-solution activity which will not transform an unpatentable principle into a patentable process. That is to say the significant step of determining a disposition of said vehicular part is

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not being performed by a machine particular or otherwise and therefore the method steps fail to be significantly tied to any particular machine.

Further, applicant's method steps fail the second prong of the test because there is no underlying subject matter has been transformed.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **Claims 28, 29, 31, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao (US2002/0016655A1).**

As per claim 28, Joao discloses a data center used in a remote evaluation of a vehicular part (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said data center comprising:

a computer server adapted to communicate with a vehicular dealer and an assessment center (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the first location and the second location that could be any of the computers connected to the network), said computer server comprising:

input means for receiving, from said vehicular dealer, said electronic folder including said description information regarding said condition of said vehicular part in

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an electronic folder (Page 21, paragraph 283; discloses that the user enters information that is to be sent to the central server via a computer. Page 12, paragraph 173; discloses various input devices to enter information into the system);

output means for sending said description information to said assessment center (Page 15, paragraph 213; discloses output devices the could be used by the system); and

said input means for receiving, from said assessment center, an assessment based on said description information, said assessment comprising a grade for the vehicular part, said electronic folder having been modified at said assessment center to include said grade of said assessment (Page 22, paragraph 293; discloses the user being sent the report or assessment. Page 12, paragraph 173; discloses various input devices to enter information into the system).

said output means for sending said electronic folder including said grade to the vehicular dealer where the grade will be used to determine a disposition of the vehicular part (Page 15, paragraph 213; discloses output devices the could be used by the system).

The information being transfer or sent and received is considered to be non-functional descriptive material since it adds not further limitations to the structure of the system and is therefore given little or no patentable weight.

As per claim 29, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said

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vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 31, Joao discloses the above-enclosed invention, Joao further discloses comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 32, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

As per claim 36, Joao discloses the above-enclosed invention, Joao further comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1, 2, 4-7, 9-20, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: “Parts Remanufacturing in the Automotive Industry” (First Quarter 1997) hereafter Hormozi.

As per claim 1, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers) comprising:

obtaining, from a vehicular dealer, description information regarding said vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending, from a central server, said electronic folder including said description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving from said assessment center, the electronic folder updated with an assessment based on said description information, said electronic folder being modified at said assessment center to include said assessment, said assessment comprising a grade (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") for the vehicle part (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well);

said central server outputting said assessment to said vehicular dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server); and

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches determining whether said vehicular part may be recycled based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is

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equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

As per claim 2, the combination Joao and Hormozi teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 4, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 5, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said data and reports are compatible with

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internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 6, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein said disposition of said vehicular part comprises at least one of discarding the vehicular part and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the

vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 7, the combination Joao and Hormozi teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 9, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 10, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said data and reports are in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 11, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses that the system is used to facilitate the process of repairing parts or performing services associated with those parts (Page 22,

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paragraph 290; discloses the central server takes in information that will help in the repair process for parts and services). Joao also discloses that many facilities can access the system (Page 22, paragraph 299; discloses that multiple parties can access the system in regard to repair and servicing of parts, these parties include intermediary or third party sites).

Joao fails to explicitly disclose sending said vehicular part to a third party for at least one of repair and recycling.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches sending vehicular parts to a third party and that services provided by the third party include repair and recycling (Page 26, paragraphs 2 and 6; teach that there are five services that can be performed two of which are repair and recycling, and that 90% of sales come from independent channels such as third parties. Page 26, paragraph 8; teaches that companies like Ford motor company have often relied on third party sites to repair and remanufacture items since they did not have the resources, from this it would be obvious that in the case of repair and recycling of parts third parties would be used if the facilities such as the dealer does not have the resources on site to complete the task. Also it would have been obvious that since these third party sites are not located on site they would have to have the parts sent to them).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of sending third parties parts for repair or recycling taught by Hormozi, to accomplish the required services for the customer. As

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mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy than having those parts repaired or recycled. Since the system is dealing with third parties or companies that are not onsite the parts that have to be services would have to be sent to them in order for them to be repaired or recycled.

As per claim 12, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses providing an assessment detail based on vehicular parts (Page 22, paragraph 289; discloses that the different services providers can provide a diagnosis or an assessment regarding the state of disrepair of the part).

Joao fails to explicitly disclose comprising at least one of identifying and ordering missing materials required for a remanufacturing of said vehicular part based on said assessment details.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising at least one of identifying and ordering missing materials required for remanufacturing of said vehicular part based on said assessment details (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced).

As per claim 13, the combination Joao and Hormozi teaches the above-enclosed invention; Joao fails to fully disclose comprising the automatically ordering said materials required for remanufacturing of said vehicular part.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising the automated ordering of said materials required for remanufacturing of said vehicular part (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced and that these pieces are ordered automatically if it is guaranteed that those parts will be replaced, as stated with a RF rating of 1.00, which states that every time the person in going to remanufacture that part, that piece is going to have to be replaced every time).

As per claim 14, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses that original equipment manufacturers have intermediaries or third parties handle things (Page 2, paragraph 21; discloses that intermediaries can act on behalf or the vehicle manufactures which are the OEM or original equipment manufacturers. Page 22, paragraph 299; discloses that these intermediaries can access the system at any time. Page 21, paragraph 281; discloses that the first location can be the vehicle manufacturer and/or intermediaries).

Joao fails to explicitly disclose where the representative or intermediary is authorized.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches that representatives of the original equipment manufacturer are authorized

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(Page 26, paragraph 8; teaches that Ford used outside companies as intermediaries for the exchanged of parts and services and those intermediaries were authorized representatives).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of authorized intermediaries or third parties taught by Hormozi, for the purpose of ensuring the quality of work to their customers. If the third party did not have a high standard of work it would reflect poorly upon the original equipment manufacturer so by authorizing these companies shows the customer that these facilities are up to par with the original equipment manufacturer. Also as stated in the article this deal benefits the OEM because in some cases these they don't have the infrastructure or the resources to take on such a service so these third parties offer a reliable alternative.

As per claim 15, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein assessment center comprises at least one of an independent assessing center, an original equipment manufacturer, and a warranty processing center (Page 22, paragraph 290; discloses that the assessment can be any one of an independent assessing center or repair shop, equipment manufacturers, warranty providers as well as others).

As per claim 16, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising the step of providing access to a party at a third location to said assessment details (Page 22, paragraph 299; discloses

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that access is granted to multiple parties at any point and those parties include intermediaries or third parties. These parties can access the system to view the assessment and to add information).

As per claim 17, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said party at said third location accesses said assessment details through an Internet web browser (Page 11, paragraph 168; discloses that the invention functions on the Internet and can be accessed using a web site which accessing would have to include the use of a web browser).

As per claim 18, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses wherein said party at said third location comprises an original equipment manufacturer (Page 22, paragraph 299; discloses that at any time another party can access the system which includes the vehicle manufacturer or the original equipment manufacturer).

As per claim 19, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising the step of producing data and reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 20, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising the step of providing said data and reports in such a format as to be compatible with internal data management

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systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 38, the combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses comprising selecting an assessment center based on the description information (Page 22, paragraph 296; discloses based on the description information the user can selected an assessment center or any of the service or parts providers).

As per claim 41, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers), comprising:

inputting, at a vehicular dealer, description information regarding the vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending the electronic folder including the description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282;

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discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving the sent electronic folder at the assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center. Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, from this it is shown that the various users receive the information that was sent);

modifying the sent electronic folder at the assessment center to include an assessment based on said description information, the assessment comprising a grade for the vehicular part (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or

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grading...") (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well);

receiving the modified electronic folder at the vehicular dealer (Page 22, paragraph 293; discloses that the user can receive the diagnostic report. Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center.);

outputting said grade at the vehicular dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports or assessments to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server); and

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches disposing of the vehicular based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment

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then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy than having those parts repaired or recycled.

18. Claims 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1).

As per claim 33, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein the computer server is adapted to determine the disposition based on said grade, and wherein the output means outputs the disposition, the disposition comprising at least one of a discarding of the vehicle part and a warranty settlement for said vehicular.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty. As discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Further the grade could be as simple as pass or fail, for example the part is broken or not, and thus the settlement would be based on if the part needs to be replaced.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 34, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 37, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third

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location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

19. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi as applied to claim 1 above, further in view of Williams et al. (US 2002/0032573 A1) hereafter Williams.

As per claim 39, the combination of Joao and Hormozi teaches the above-enclosed invention, but fails to explicitly disclose printing a shipping label based on a destination identified in the determining of a disposition.

Williams, which talks about an apparatus, systems and methods for online, multi-parcel, multi-carrier, multi-service enterprise parcel shipping management, teaches printing a shipping label identifying a destination (Page 27, paragraphs [0447]-[0449]; teaches that a shipping label can be printed by the user of the system identifying a destination as well as package information details).

Therefore, from this teaching of Williams, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the printing of shipping labels that provide destination information as taught by Williams for the purpose of expediting shipping to customers as well as to service providers. By printing the labels from the stored data the user is ensured that the information is up to date and correct, which limits the room for error.

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20. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi as applied to claim 1 above, further in view of Untiedt et al. (7,216,096) hereafter Untiedt.

As per claim 40, the combination of Joao and Hormozi teaches the above-enclosed invention, but fails to explicitly disclose adding an event-driven status indicator to the electronic folder for tracking the progress of a claim concerning the vehicular part.

Untiedt, which talks about an integrated inventory management system, teaches having an event-driven status indicator for tracking the progress of a vehicular part (Col. 2, lines 23-26, Col. 6, lines 3-36; teach that upon an event happening such as a dealer agreeing or disagreeing to supply a part the information regarding that customer request is updated with the current status in this case if the part was back ordered or not).

Therefore, from this teaching of Untiedt, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the use of status indicators as taught by Untiedt for the purpose of keeping track of client requests and ensuring that the service is fulfilled. By including a status indicator the system is aware if the order has been fulfilled or not and this helps avoid possibly forgetting a service request or trying to fulfill a service request that has already been fulfilled.

21. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Park et al. (US 2001/0039594 A1) hereafter Park.

As per claim 42, Joao discloses the above-enclosed invention, Joao further discloses a central processing computer or central server (Figure 1, character 10; discloses that the system contains a central processing computer or central server), but fails to explicitly disclose comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules.

Park, which talks about a method for enforcing workflow processes for website development and maintenance, teaches comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules (Figure 1; teaches that the system includes a server. Page 5, paragraph [0058]; teaches that server includes software that validates user-entered data based on a set of predetermined rules, from this it would have been obvious given that Joao includes a website as shown page 11, paragraph [0168], to include on the server the software to validate user entered data on that website based on predetermined rules as taught by Park to ensure that the information is correct before proceeding).

Therefore, from this teaching of Park, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by Joao with the use of data validation based on rules as taught by Park, for the purpose of ensuring the data is complete and correct before proceeding. Since both Park and Joao show websites that include data entry it would have been obvious that the central server shown in Joao could be programmed to validate the information submitted by the users based on a set of predetermined rules as taught by Park.

Response to Arguments

22. Applicant's arguments filed June 4, 2009 have been fully considered but they are not persuasive.

23. In response to the applicant's argument that, "As claimed and described in the specifications, the disposition is determined based on the grade, which forms part of the assessment. The use of the term "or" in the description does not imply any equivalence. If the grade is contained in the assessment, then one may describe the return as a return of the assessment or of the grade (i.e. a return of the assessment implies a return of the grade as well since one contains the other; and inversely the grade may be returned independently of the entire assessment)." The Examiner respectfully disagrees, the applicant's specification specifically on page 9, paragraph [0034], states "As per step 37, an assessor at the assessment center determines the quality of the core using all of the core information data and additional descriptive information supplied through the electronic folder, if the electronic folder contains sufficient information in order to assess the core (at step 38), then as per step 39, the folder is then returned to the dealer along with the assessment or grading and a list of missing parts. If the assessor cannot accurately determine the quality of the core (at step 38), the assessor can request additional information from the car dealership 21 by returning

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the electronic core folder with comments or questions. The dealer will add the missing information and return the electronic folder to the assessor. The process can loop through steps 33, 35 and 37 until the assessor is satisfied that the supplied information is sufficient to permit an accurate grading of the quality of the core." From this it is shown that the assessor performs their **assessment or grading** of the parts this section shows that either the assessment or the grading itself is required to determine the assessment of the condition of the parts, this paragraph no other paragraph in the applicant's specification would lead one of ordinary skill to the conclusion that the grade is included as part of the assessment. Further the Examiner requests that the applicant show what parts of the specification specifically shows that the grade is a part of the assessment and that the grade included in the assessment is solely used to determine the disposition of the part.

24. In response to the applicant's argument that, "basic language knowledge does not lead to an equivalent interpretation of both terms. As per the Webster's English dictionary, the term "grade" refers to "a position in a scale of ranks or qualities" or "a degree of severity", while "assessment" refers to an "action or an instance of assessing, determining the rate or amount of, importance, size, value of..." There is no confusion that both terms have a different meaning and are thus not equivalent. A skilled reader would clearly understand that the assessment is to comprise a grade." The Examiner respectfully disagrees, as stated above the applicant has not shown a place in the specification where the applicant has specifically stated that the assessment is made up of a grade. Further Dictionary.com defines "assessment" to be the act of assessing;

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appraisal; evaluation. The term "assessing" is defined as either to fix or determine the amount of or to estimate or judge the value, character, etc., of; evaluate. The term "grade" is defined by Dictionary.com as a degree or step in scale, as of rank, advancement, quality, value, or intensity. Clearly it shown that a grade is a value and assessing a product is judging its value so both grading and assessing are to judging the value of something. From this it is shown that both terms are equivalent since either term can be used for the act of determining something's value. One of ordinary skill would understand that both these terms are considered equivalent and used to determine the worth of a product. As stated above the applicant's specification does not clearly show the grade being different from the assessment or that assessment includes the grade, the rejection is therefore maintained.

25. In response the to applicant's argument that, "To be sure, a simple example will illustrate the Applicant's argument. A person is asked to go the market to purchase a fruit salad (comprising oranges) or oranges. Inevitably, he will return from the market with oranges (either in the fruit salad or by themselves), but not necessarily with a fruit salad. Furthermore, anyone will understand that a fruit salad is not equivalent to oranges." It is unclear to the Examiner what the applicant is trying to prove with this example. It is unclear as to what the applicant is equating each element to, is the fruit salad the assessment or the electronic folder? As best understood by the Examiner the fruit salad is supposed to represent the assessment and the oranges are supposed to represent the grade. However as shown above the grade is never shown to be included in the assessment, the grade is shown to be included in the electronic folder itself as per

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page 6 paragraph [0020], but not shown to be part of the assessment. Therefore the analogy of fruit salad and oranges doesn't work since the applicant has stated that the fruit salad contains oranges but at no point in the applicant's specification does the applicant state that the assessment contains a grade. As best understood by the Examiner the grade is a means to determine the part's value, and the assessment is also a means to determine the part's value thus both terms are interchangeable and equivalent. For this reason the rejections have been maintained.

26. In response to the applicant's argument that, "claim 1 and 41 are hereby amended to tie the method steps to another statutory class (such as the central server), and positively recite the subject matter transformed (such as per the outputting step)," the Examiner respectfully disagrees. As shown in the 101 rejection above the step of outputting is considered to be insignificant extra-solution activity and does not constitute as a significant tie to a particular machine.

27. In response to the applicant's argument that, "Joao refers to a vehicle while the claims refer to a condition of a vehicular part. These terms are far from equivalent," the Examiner respectfully disagrees. A vehicle itself is comprised of various parts and when giving the condition of a vehicle the condition will be relayed in various parts that need to be fixed or replaced. Further Joao states on page 12 paragraph 179 and page 13 paragraph 180, that it stores information regarding vehicle parts and that this same database is used to help diagnose problems. From this the Examiner asserts that the vehicle contains parts and the list of parts is stored and tracked in the system, and further this information is included in the diagnosis of problems and state of disrepair so

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the system described in Joao reads over the claims as currently written. For example one of ordinary skill in the art of automotive repair, or any person who has had their vehicle repaired would know when an assessment of the vehicle is done the condition of the vehicle is conveyed to the user through the parts of the vehicle. That is to say, if your vehicle is brought to a shop for repairs the service center isn't going to say your vehicle is broken as suggested by the applicant but rather they will say your car needs elements A, B, and C fixed for example you may need new brakes, a new fuel pump and new shocks. These individual parts will be relayed to the user as to their condition and/or grade in this case they are broken or worn and need to be replaced.

Further as stated above in the rejection the type of data being stored, inputted and outputted is considered to be non-functional descriptive material. The type of information is considered to be non-functional descriptive material since it has little if anything to the structure of the system disclosed in claim 28. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In *re* Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional

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relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the type of information being input, output and stored adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the structure is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the structure of the system as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Therefore the Examiner maintains that Joao discloses all of the structural elements of the claim, and that one of ordinary skill would know that when describing the state of disrepair of any vehicle by a service repair personnel it would be by the parts and their current state of disrepair as shown in the example above. Therefore the rejections are maintained.

28. In response to the applicant's argument that, "Joao teaches an output device for outputting data or reports such as "a diagnostic report, a repair report, a maintenance report, and a servicing report" (abstract). In view of this and point (1) above, Joao therefore does not teach output means as claimed," the Examiner respectfully

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disagrees. It is not clear how the applicant is arguing that point (1) shows how the Joao reference fails to disclose the claimed outputting means; however point (1) is discussed above. As per point (2) the Examiner did not cite the abstract in the teaching of the output means, however the full abstract also discloses that the server also includes "a transmitter for transmitting at least one of the at least one vehicle diagnostic information, vehicle repair information, vehicle maintenance information, and vehicle servicing information, to a communication device associated with an individual," which is more than what is asserted by the applicant. Further the Examiner points the applicant to the point in Joao previously cited for the rejection of claim 28, Page 15, paragraph 213 of Joao, which states "the central processing computer 10 also includes an output device 101 for outputting any data, information, report, etc., described herein. In the preferred embodiment, the output device 101 can be a printer, a display, a transmitter, a modem, and/or any other device which can be used to output data." Since the Examiner can not find any structural difference between the claimed output means and the output means shown in Joao, the Examiner asserts that clearly Joao does disclose the output means as claimed. The Examiner asserts that the applicant has failed to show how the claimed outputting means is not equivalent to the outputting means recited by the Examiner. The rejection is therefore maintained.

29. In response to the applicant's argument that, "These rejections are moot in view of the arguments and amendments submitted above, and more specifically, in view of the fact that an assessment is not equivalent to a grade. The applicant respectfully submits that none of the prior art teaches the subject matter as claimed," the Examiner

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respectfully disagrees. As discussed above the assessment is found to be equivalent to the grade and the applicant has failed to show otherwise. For this reason as well as the other reasons stated above the rejections under 103 have been maintained.

30. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over Joao and Hormozi where applicable.

Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Dennis Ruhl/
Primary Examiner, Art Unit 3689